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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,009	02/14/2002	Samuel H. Slishman	UNME-0118-1	9066
22208	7590	12/02/2004	EXAMINER	
ROBERTS ABOKHAIR & MARDULA SUITE 1000 11800 SUNRISE VALLEY DRIVE RESTON, VA 20191			MENDEZ, MANUEL A	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,009

Applicant(s)

SLISHMAN, SAMUEL H.

Examiner

Manuel Mendez

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,28-31,34 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,31,34 and 37-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,7 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date AUG/02 and OCT/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

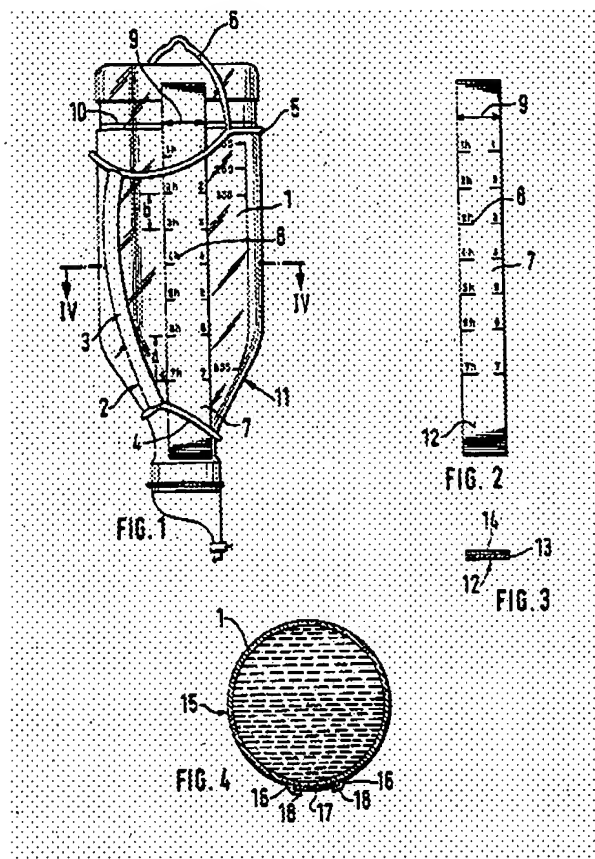
DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over (Ellsworth or Maki) in view of Felk. The Ellsworth and Maki Patents disclose syringes comprising of a syringe barrel having a plurality of measuring indicia. Moreover, the indicia on the surface of the syringes are expressly disclosed as numeric and volumetric. However, the use of non-volumetric indicia is conventional in the art of dispensing as evidenced by the teachings of Fekl.



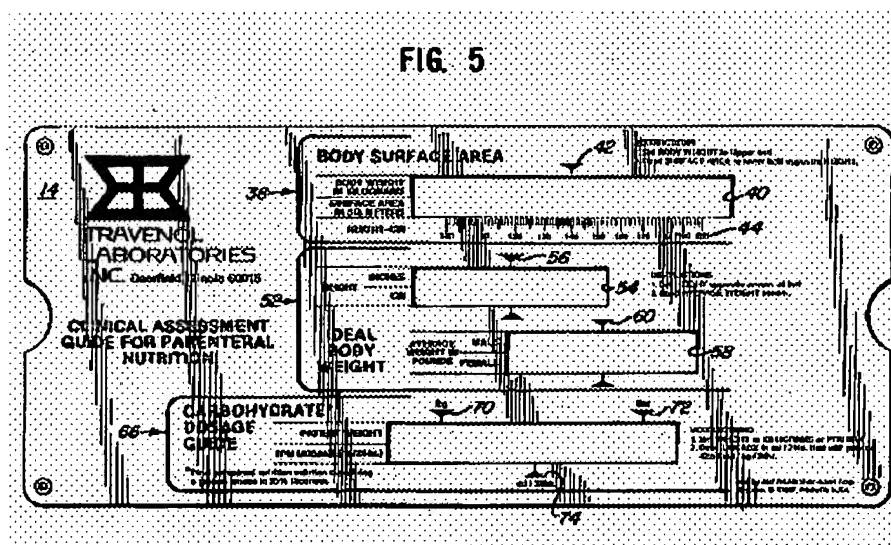
In figures 1 and 2, the **Felk Patent** shows a scale (8) calibrated in hours, a numeric non-volumetric measuring indicia. Importantly, the scale is positioned on the outer surface of the container. Based on the teachings of the Felk Patent, for a person of ordinary skill in the art, the use of numeric non-volumetric measuring indicia in any dispensing system, such as a syringe, would have been considered an obvious design choice.

ANALYSIS

Volumetric measuring markings are utilized in dispensing systems due to the many variables that must be considered to accurately determine a correct dosage for infusion into the body. Because of the many variables, volumetric markings are used in

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order to have a common denominator among all the variables used. The examiner notes for the record, that the teachings of the Cohen and Ausman, et al., Patents suggest that when multiple variables are utilized it is conventional to use volumetric markings.



For example, in figure 5 of the Ausman, et al., Patent, the input variables are weight in kilograms and height in inches to determine a TPN dosage in ml/24 hrs. Obviously, if only one variable is utilized, such as age or weight, there would be a direct relationship between the variable and the dosage amount, and therefore, numeric markings representing age or weight would be safe for use in the surface of the dispensing system. Based on the above analysis, the following rejection is presented for applicant's review.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **(Ellsworth or Maki) in view of Felk, and in further view of Cohen, and Ausman, et al.** The Felk Patent demonstrates that the use of non-volumetric markings is conventional in the art. Moreover, as discussed above, medical personnel are required to use volumetric markings because accurate dosage determination requires more than one input variable. However, if only one variable is utilized, such as weight or age, it would be obvious for a person of ordinary skill in the art to use non-volumetric markings since there is a direct relationship between the input variable and the dosage. Conclusively, since the Felk Patent demonstrates that the use of non-volumetric markings is conventional, the modification of the outer markings in any dispensing apparatus with non-volumetric markings such as weight or age would have been considered obvious.

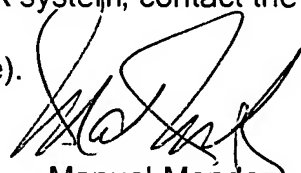
Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over **(Ellsworth or Maki) in view of Felk, Cohen, and Ausman, et al., and in further view of Alessi and Whitmire.** None of the patents presented in the previous rejections disclose means for adjusting the location of the numeric non-volumetric measuring indicia with respect to the syringe barrel. However, said means are conventional as

demonstrated by the teachings of **Alessi and Whitmire**. Both patents disclose proportioning devices that operate by adjusting the location of the numeric non-volumetric measuring indicia with respect to a tubular body. Based on the teachings of Alessi and Whitmire, modifying dispensing systems, such as syringes, with the adjusting means disclosed by the applicant would have also been considered an obvious design choice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel Mendez whose telephone number is 703-308-2221. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manuel Mendez
Primary Examiner
Art Unit 3763

MM